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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,665	10/10/2001	Kohichiro Kodama	KOD69A.001AUS	1390

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EXAMINER	
HARTMANN, GARY S	
ART UNIT	**PAPER NUMBER**
3671	

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/976,665	KODAMA ET AL.	
	Examiner	Art Unit	
	Gary Hartmann	3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 October 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the reflecting mirror, luminescent paint, and optical fiber must be shown or the features canceled from the claims. No new matter should be entered.

2. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The abstract of the disclosure is objected to because it is an unintelligible run-on type sentence. The abstract must clearly state the object of the invention. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For example, the terms "zonally" and "forefront" do not clearly define spatial relationships; the term "near" in claim 7 is indefinite because it is a relative term; and the terms "the other end," "means for sensing," "said sensor," and "the second oncoming vehicle" in claims 4, 5, 7, 11, and 12 lack proper antecedent bases.

7. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The terms "emitting" and "emits," used throughout the claims, is used to mean "to reflect," while the accepted meaning is "to give out."

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

9. Claims 1, 2, 5, 8, 9, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by each of: Gillner et al. (U.S. Patent 4,978,207); Voelker et al. (U.S. Patent 3,200,705); Cardarelli (U.S. Patent 2,164,985); Wing (U.S. Patent 1,930,917); and van Gelder (U.S. Patent 1,837,085).

Each of these patents discloses a mirror situated along a roadway (Gillner et al., 1; Voelker et al., 14; Cardarelli, 6; Wing, 13; van Gelder, 6-9). Because a turn signal of an oncoming vehicle would inherently be reflected, the claim limitations are met.

10. Claims 1, 2, 5, 8, 9, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Kushida (U.S. Patent 6,264,334). Kushida discloses a mirror (2) situated along a roadway. Because a turn signal of an oncoming vehicle would inherently be reflected, the claim limitations are met.

11. Claims 1, 3, 5, 8, 10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by each of Anders (U.S. Patents 5,665,793 and 5,472,737) and Feuvray (U.S. Patent 4,248,001). Each of these patents discloses a luminescent paint to be placed as desired along a roadway (see abstracts of Anders; Feuvray, column 4, lines 61-68, for example). Because a turn signal of an oncoming vehicle would inherently be reflected, the claim limitations are met.

12. Claims 1, 4, 5, 8, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by each of: Swemer (U.S. Patent 5,042,894); Eigenmann (U.S. Patent 4,993,868); Callhan (U.S. Patent 4,737,049); and Wyckoff (U.S. Patent 4,069,787). Each of these patents discloses an optical fiber placed along a roadway (Swemer, abstract; Eigenmann, Figure 3A, for example; Callhan, Figure 13, for example; Wyckoff, column 3, lines 29-63, for example). Because a turn signal of an oncoming vehicle would inherently be reflected, the claim limitations are met.

13. Claims 1, 4, 5, 8, 11, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Custers et al. (U.S. Patent 6,305,874). Custers et al. disclose an optical fiber mounted on a roadway (Figure 1, for example). Because a turn signal of an oncoming vehicle would inherently be reflected, the claim limitations are met.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of: Gillner et al., Voelker et al., Cardarelli, Wing, van Gelder, Kushida, Anders, Feuvray, Swemer, Eigenmann, Callhan, Wyckoff, and Custers et al., as applied above. The position in which the device was installed on the roadway is a standard practice design consideration. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed the apparatus of any of the above devices as claimed in order to convey information in a desired manner. In other words, positioning of a roadway marking device is not patentable because it is within the scope of standard design practice.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional references teach roadway marking devices.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Hartmann whose telephone number is 703-305-4549. The examiner can normally be reached on Monday through Friday, 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 703-308-3870. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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November 4, 2002

Gary Hartmann
Primary Examiner
Art Unit 3671